

PATENT Attorney Docket No. A-68718-3 Attorney File No.: 463037-00219

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

KAYYEM et al.

Serial No. 19/904,175

Filed: July 11, 2001

Devices and Methods for Biochip

Multiplexing

Examiner: FORMAN, Betty J.

Art Unit: 1634

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Date:	August 12, 2005	
Signature	7	
Signature	Brent Yonehara	

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT STATEMENT OF RELATEDNESS

Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

In satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and in accordance with the provisions of 37 C.F.R. §§ 1.97 and 1.98, Applicants wish to draw the attention of the U.S. Patent and Trademark Office to the references cited on the accompanying form PTO/SB/8A. In accordance with 1287 O.G. 163, 10/19/2004, no copies of U.S. patents and published applications are enclosed. Copies of all other foreign patents and non-patent literature are enclosed.

Further, in accordance with the provisions of 37 C.F.R. § 1.98(a)(3) and MPEP § 609(III)(A)(3), Applicant submits that reference nos. B1, B9, and B10 are not in the

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Serial No.: 09/904,175 Filed: July 11, 2001

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English language and directs the Examiner's attention to the English language abstract of same enclosed herewith for a concise statement as to its relevance.

Further, in satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and as required by M.P.E.P. § 2001.06(b), Applicant notes that the present application is related to the following pending patent applications:

- U.S.S.N. 09/760,384, filed January 11, 2001; U.S.S.N. 09/993,342, filed
 November 5, 2001; U.S.S.N. 10/412,660, filed April 11, 2003;
- U.S.S.N. 09/440,371, filed November 12, 1999; U.S.S.N. 09/520,477,
 March 8, 2000; U.S.S.N. 09/712,792, filed November 13, 2000; U.S.S.N. 10/823,503, filed April 12, 2004; and
- 3. U.S.S.N. 09/295,691, filed April 21, 1999; U.S.S.N. 11/043,515, filed January 25, 2005.

Nothing herein shall constitute an admission concerning the contents of any of the cited references, nor shall the inclusion of a reference herein be considered an admission that the reference constitutes prior art against the invention claimed in the above-identified application. Submission of the present document shall not be construed as an admission that a search has been made or that better art does not exist.

Pursuant to 37 C.F.R. §1.97(c), enclosed is a check in the amount of \$180.00 as set forth in 37 C.F.R. §1.17(p). While no fee is believed to be due, if this belief is in error, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2319 (File No.: 463037-00219; Docket No.: A-68718-3).

Serial No.: 09/904,175 Filed: July 11, 2001

Please direct further questions in connection with this Application to the undersigned at (415) 781-1989.

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: Hymot 12 2005 By:

Customer No.: 92940

555 California Street, Suite 1000 San Francisco, CA 94104-1513 Telephone: (415) 781-1989

Facsimile: (415) 398-3249

Timothy A. Worrall, Reg. No. 54,552 for

Robin M. Silva, Reg. No. 38,304

Filed Under 37 C.F.R. § 1.34

Attachments: Form SB/08/A-B, substitute for Form PTO-1449

195 cited references

Substitute PTO/SB/08A (08-03) U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE.

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Complete if Known 09/904,175 Application Number Filing Date July 11, 2001 First Named Inventor DUONG, Hau Art Unit 1634 FORMAN, Betty J. **Examiner Name** A-68718-3 (463037-00219) Attorney Docket Number

	U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No.1	Document Number Number-Kind Code ² (<i>if known</i>)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	
	A1	4,908,319	03-13-1990	Smyczek at al.		
	A2	4,945,045	07-31-1990	Forrest et al.		
	A3	5,038,852	08-13-1991	Johnson et al.		
	A4	· 5,100,775	03-31-1992	Smyczek at al.		
	A5	5,108,573	04-28-1992	Rubinstein et al.		
	A6	5,126,022	06-30-1992	Soane et al.		
	A7	5,126,034	06-30-1992	Carter et al.		
	A8	5,143,854	09-01-1992	Pirrung et al.		
	A9	5,147,607	09-15-1992	Mochida		
	A10	5,187,096	02-16-1993	Giaver et al.		
	A11	5,192,412	03-09-1993	Kambara et al.		
	A12	5,194,133	03-16-1993	Clark et al.		
	A13	5,200,051	04-06-1993	Cozzette et al.		
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	A31	5,601,982	02-11-1997	Sargent et al.		

Examiner	Date Considered	
Signature	Considered	

^{*}EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not

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Application Number	09/904,175				
Filing Date	July 11, 2001				
First Named Inventor	DUONG, Hau				
Art Unit	1634				
Examiner Name	FORMAN, Betty J.				
Attorney Docket Number	A-68718-3 (463037-00219)				

	U.S. PATENT DOCUMENTS					
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	A32	5,605,662	02-25-1997	Heller et al.		
	A33	5,620,850	04-15-1997	Bamdad et al.		
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	A36	5,653,939	08-05-1997	Hollis et al.		
	A37	5,657,208	08-12-1997	Noe et al.		
	A38	5,670,322	09-23-1997	Eggers et al.		
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	A41	5,755,942	05-26-1998	Zanzucchi et al.		
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	A61	5,942,443	08-24-1999	Parce et al.		
	A62	5,945,334	08-31-1999	Besemer et al.		

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Signature			

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Examiner Initials*										
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Examiner Initials*	Cite No.1	Foreign Patent Document Country Code ² Number ⁴ Kind Code ⁵ (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T⁵		
	B1	DE 1 9725 190	12-17-1998	Innova GmbH				
	B2	EP 0 142 301	05-22-1985	Serono Diagnostics Limited		<u> </u>		
	В3	EP 0 213 825	03-11-1987	Molecular Devices Corp				
	B4	EP 0 339 821 A1	11-02-1989	United Kingdom Atomic Energy Authority				
_	B5	EP 0 854 362 A2	07-22-1998	Japan Science & Technology Corp				
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	B7	EP 0 870 541 A2	10-14-1998	Eastman Kodak Co.				
	B8	EP 0 969 083 A1	01-05-2000	Olympus Optical Co. Ltd.		<u> </u>		
	В9	JP 11-183437 A	07-01-1999	Shimadzu Corp.				
	B10	JP 63-238166 A	10-04-1988	Mitsubishi Corp.				
	B11	WO 97/09337 A1	03-00-1997	Deutsches Krebsforschungszentrum Stiftung des Öffentlichen Rechts				
	B12	WO 98/50154 A1	11-00-1998	University of Minnesota				
-	B13	WO 93/22053 A1	11-11-1993	The Trustees of the University of Pennsylvania				
	B14	WO 93/22678 A2/A3	11-11-1993	Massachusetts Institute of Technology	,			
	B15	WO 93/25898 A1	12-23-1993	Medisense, Inc.				

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	B16	WO 94/22889 A1	10-13-1994	Cis Bio International			
<u></u>	B17	WO 95/11755 A1	05-04-1995	Houston Advance Research Center			
	B18	WO 97/12030 A1	04-03-1997	Nanogen, Inc.			
	B19	WO 97/27324 A1	07-31-1997	David Sarnoff Research Center			
	B20	WO 97/27473 A1	07-31-1997	Northwestern University			
	B21	WO 97/31256 A1	08-28-1997	Cornell Research Foundation, Inc.			
	B22	WO 97/36681 A1	10-09-1997	Perkin Elmer Corp.			
	B23	WO 97/41425 A1	11-06-1997	Pence, Inc.			
	B24	WO 97/44651 A1	11-27-1997	Australian Membrane and Biotechnology Institute			
	B25	WO 98/01758 A1	01-15-1998	Nanogen, Inc.			
	B26	WO 98/15893 A1	04-16-1998	Advanced Risc Mach Ltd.			
	B27	WO 98/27229 A1	06-25-1998	University of Chicago			
	B28	WO 98/28444 A2/A3	07-02-1998	University of Chicago			
	B29	WO 98/43739 A2/A3	10-08-1998	Biosite			
	B30	WO 98/49344 A1	11-05-1998	Lockheed Martin Energy Research Corp.			
-	B31	WO 98/49557 A1	11-05-1998	B-E Safe, Inc.			
	B32	WO 99/07879 A1	02-18-1999	Fraunhofer Inst. Siliziumtechno, Univ. of Souther CA			
	B33	WO 99/14596 A1	03-25-1999	AB Sangtec Medical			
•	B34	WO 99/17093 A1	04-09-1999	The Regents of the University of Michigan			
	B35	WO 99/26729 A1	06-03-1999	Universite de Montreal			
	B36	WO 99/29711 A1	06-17-1999	Nanogen, Inc.			
<u></u>	B37	WO 01/34302 A2	05-17-2001	Motorola, Inc.			
	B38	WO 01/42508 A2	06-14-2001	Motorola, Inc.			
	B39	WO 01/54813 A2/A3	08-02-2001	Clinical Micro Sensors, Inc.			

Examiner	Date
Signature	Considered

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	Substitute for		A/PTO	Complete if Known		
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S	TATEMENT	BY AF	PLICANT	First Named Inventor	DUONG, Hau	
				Art Unit	1634	
	(use as many sl	heets as ne	cessary)	Examiner Name	FORMAN, Betty J.	
Sheet	5	of	13	Attorney Docket Number	A-68718-3 (463037-00219)	

		NON PATENT LITERATURE DOCUMENTS	
Examiner Initials*	Cite No.1	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ⁶
	C1	AIZAWA, M., et al., "Integrated molecular systems for biosensors," Sens. Actuators B Chem. 24(1&3):1-5 (Mar. 1995).	
	C2	ALBERS, W., et al., "Design of novel molecular wires for realizing long-distance electron transfer," <i>Bioelectrochem. Bioenerg.</i> 42(1):25-33 (Apr. 1997).	
	C3	ALSFASSER, R., et al., "Novel Building Blocks for Biomimetic Assemblies. Synthesis, Characterization, and Spectroscopic and Electrochemical Properties of New Bidendate Ligands Derived from Lysine and Cystine and Their Complexes with Bis(2,2'-bipyridine)ruthenium(II)," <i>Inorg. Chem.</i> 35(3):628-636 (Jan. 1996).	
~~	C4	ARKIN, M., et al., "Evidence for Photoelectron Transfer Through DNA Intercalation," J. Inorg. Biochem. Abstr., 6th Int. Conf. Bioinorg. Chem. 51(1&2):526 (1993).	
	C5	ARKIN, M., et al., "Rates of DNA-Mediated Electron Transfer Between Metallointercalators," <i>Science</i> 273(5274):475-480 (Jul. 1996).	
	C6	BEATTIE, K., et al., "Advances in Genosensor Research", Clin. Chem. 41(5):700-706 (1995).	
	C 7	BECKER, H., et al., "Microfluidic manifolds by polymer hot embossing for μ-TAS applications," <i>Micro Total Analysis Systems</i> '98, <i>Proc.</i> μ-TAS '98, pp. 253-256, Banff, BC, CA (Oct. 13 - 16, 1998).	
	C8	BELGRADER, P., et al., "Rapid pathogen detection using a microchip PCR array instrument," Clin. Chem. 10(44):2191-2194 (1998).	
	C9	BIGNOZZI, C., et al., "A simple poly(pyridine)ruthenium(II) photosensitizer: (2,2'-bipyridine)tetracyanoruthenate(II)," <i>J. Am. Chem. Soc.</i> 108(24):7872-7873 (Nov. 1986).	
	C10	BILEWICZ, R., et al., "Monomolecular Langmuir-Blodgett films at electrodes: electrochemistry at single molecule 'gate sites'," Langmuir 11(6):2256-2266 (Jun. 1995).	
	C11	BJERRUM, M., et al., "Electron transfer in ruthenium-modified proteins," <i>J. Bioenerg. Biomembr.</i> 27(3):295-302 (Jun. 1995).	
	C12	BLONDER, R., et al., "Application of Redox Enzymes for Probing the Antigen-Antibody Association at the Monolayer Interfaces: Development of Amperometric Immunosensor Electrodes," <i>Anal. Chem.</i> 68(18):3151-3157 (Sep. 1996).	
	C13	BOWLER, B.E., et al., "Long-Range electron transfer in donor (spacer) acceptor molecules and proteins," <i>Prog. Inorg. Chem. Bioinorg. Chem.</i> 38:259-322 (1990).	
	C14	BRUN, A., et al., "Photochemistry of intercalated quaternary diazaaromatic salts," <i>J. Am. Chem. Soc.</i> 113(21):8153-8159 (Oct. 1991).	
	C15	BUMM, L.A., et al., "Are single molecular wires conducting?," Science 271(5226):1705-1707 (Mar. 1996).	
	C16	CARLSSON, C., et al., "Screening for genetic mutations," Nature 380(6571):207 (Mar. 1996).	
-	C17	CARTER, M., et al., "Electrochemical investigations of the interaction of metal chelates with DNA. 3. Electrogenerated chemiluminescent investigation of the interaction of tris(1,10-phenathroline)ruthenium(II) with DNA," <i>Bioconjug. Chem.</i> 1(4):257-263 (Jul Aug. 1990).	

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S	TATEMENT B	Y AF	PLICANT	First Named Inventor	DUONG, Hau	
				Art Unit	1634	
	(use as many shee	ets as ne	cessary)	Examiner Name	FORMAN, Betty J.	
Sheet	6	of	13	Attorney Docket Number	A-68718-3 (463037-00219)	

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Application Number	09/904,175			
Filing Date	July 11, 2001			
First Named Inventor	DUONG, Hau			
Art Unit	1634			
Examiner Name	FORMAN, Betty J.			
Attorney Docket Number	A-68718-3 (463037-00219)			

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IN	IFORMATIO	N DISC	LOSURE	Filing Date	July 11, 2001		
S	STATEMENT BY APPLICANT			First Named Inventor	DUONG, Hau		
				Art Unit	1634		
(use as many sheets as necessary)			essary)	Examiner Name	FORMAN, Betty J.		
Sheet	12	of	13	Attorney Docket Number	A-68718-3 (463037-00219)		

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